REMARKS

Introduction

Upon entry of the foregoing response, claims 1-4, 6-8, 10-17 and 19 are pending in the application. Claims 1 and 15 have been amended. No new matter is being presented. In view of the following remarks, reconsideration and allowance of all pending claims are requested.

Entry of this Amendment After Final is proper under 37 C.F.R. §1.116 because the claim amendments: (a) place this application in condition for allowance (for the reasons discussed herein), (b) do not raise any new issues requiring further search and/or consideration (since the amendments amplify issues previously discussed throughout prosecution as indicated in the Final Office Action), (c) present the rejected claims in better form for consideration on appeal (should an appeal be necessary), and (d) are necessary and were not earlier presented because they are made in response to arguments raised in the Final Office Action. Accordingly, for at least the reasons discussed below, entry of the Amendment After Final is respectfully requested.

Obviousness-type Double Patenting Rejection

Claims 1-4, 6-8, 10-17 and 19 have been provisionally rejected under the non-statutory, judicially created doctrine of obviousness-type doubling patenting as being unpatentable over claims 1-5, 7-13, 15-21, 23 and 25 of co-pending U.S. Patent Application No. 10/675,614 in view of U.S. Patent Publication No. 2002/0017977 Wall (hereinafter "Wall"). Applicant respectfully requests reconsideration and withdrawal of this provisional rejection, for at least the following reasons.

In the interest of continuing the prosecution of the instant application, Applicant submits herewith a Terminal Disclaimer to obviate this provisional rejection, under authority of M.P.E.P. 804.02, II which states in pertinent part, that "[a] rejection based on a nonstatutory type of double patenting can be avoided by filing a terminal disclaimer in the application or proceeding in which the rejection is made." In view of the Terminal Disclaimer submitted herewith, in accordance with 37 C.F.R. 1.321 and M.P.E.P 1490, Applicant respectfully requests withdrawal of this provisional rejection of these claims.

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Rejection under 35 USC §112

Claims 1-4, 6, 7 and 15-17 have been rejected under 35 U.S.C. §112, 1st paragraph as allegedly failing to comply with the written description requirement. Applicant respectfully requests reconsideration and withdrawal of this rejection, for at least the following reasons.

Claim 1

Independent claim 1 has been amended to more clearly define the invention.

The Examiner describes on page 6 of the Office Action the basis of this rejection, and states that "[n]owhere in the specification is it recited that these two requirements (downloading only if the location is determined to be secure and only if the computer does not receive GPS) should or could occur together. Applicant respectfully objects to this statement and points out that the Examiner has not properly recited the previously, or presently, claimed features of independent claim 1, but instead has provided paraphrased language from the specification which paraphrased language is certainly not the same as the actual language currently recited in claim 1.

Paragraph [0021] of the specification describes that the location service 204 receives a real-time GPS coordinate from the client computer 100 to indicate the real-time physical location of the client computer 100. A location service 204 compares the real-time GPS coordinate with a list of approved locations 210 for an application 208, such that if the location of the client computer 100, based on the real-time coordinate, is within a range of locations in the list of approved locations 210 then the application 208 is permitted to be downloaded to the client computer 100.

However, paragraph [0023] of the instant specification describes that the computer 100 may send GPS location information from its GPS receiver 122 (that is, the real-time GPS coordinate described in paragraph [0021]), or may send non-GPS location information derived from another "location identifier" (that is, the location information is not provided by the GPS receiver 122), to determine the real-time location of the client computer 100. Thus, the application 208 may be downloaded based upon comparison of a GPS derived signal or a non-GPS derived signal to determine whether or not to allow the downloading of the application 208.

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The first line of paragraph [0026] reinforces this concept and describes that the authorized location list 210 may include location coordinates supplied by a non-GPS source which may be an enterprise defined system.

The first line of paragraph [0027] of the instant specification makes clear to one of skill in the art that, in view of the above-described portions of the instant specification, the "location service 204 may be structured such that the presence or lack of a GPS or other location signal" detected by the client computer 100 "either enables or prohibits the loading of an application [208]." (Emphasis added) That is, if a non-GPS signal is present it may enable the application 208 to be downloaded by the computer 100, and if a GPS signal is not present it may enable the application 208 to be downloaded by the computer 100. Thus, as described in the instant specification, these conditions may both occur and they are not mutually exclusive.

Therefore, the currently recited features of the method of claim 1, which include "downloading the first software only if the physical location of the client computer is within the range of one of the authorized location ranges from the first list of authorized location ranges [which, according to the portions of the instant specification described above may be a non-GPS based coordinate] and the client computer does not receive information derived from a GPS signal," are not inconsistent with the description of these features as described in the instant specification. (Comments within quotes added) Applicant respectfully submits that one of skill in the relevant art would understand from reading the instant specification that the above currently recited features of claim 1 are not inconsistent and that the Applicant at the time the instant application was filed had possession of the claimed invention. Accordingly it is respectfully requested that the rejection of this claim be withdrawn, and allowance of claim 1 is earnestly solicited.

Claim 15

Independent claim 15 has been amended to more clearly define the invention.

For at least the reasons given above in regard to amended independent claim 1, one of skill in the relevant art would understand from reading the instant specification, described above, that the following currently recited features of claim 15 are not inconsistent and that the Applicant at the time the instant application was filed had possession of the claimed invention.

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Applicant submits that the currently recited features of the computer program product of claim 15 include "program code for downloading the first software only if the physical location of the client computer is within the range of one of the authorized location ranges from the first list of authorized location ranges and a Global Positioning System (GPS) receiver on the client computer does not detect a GPS signal," are not inconsistent with the description of these features as described in the instant specification. Accordingly it is respectfully requested that the rejection of this claim be withdrawn, and allowance of claim 15 is earnestly solicited.

Claims 2-4, 6, 7 and 16-17

Regarding dependent claims 2-4, 6, 7 and 16-17, since these claims depend from amended independent claim 1 or 15, they include all of the features of the independent claim from which they respectively depend, as described above. For at least the reasons given above regarding independent claims 1 and 15, Applicant respectfully submits that the recited features of these dependent claims are not inconsistent and that the Applicant at the time the instant application was filed had possession of the claimed invention of these dependent claims. Accordingly it is respectfully requested that the rejection of this claim be withdrawn, and allowance of claims 2-4, 6, 7 and 16-17 is earnestly solicited.

Rejection under 35 USC §103

Claims 8, 10-12 and 19 have been rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication No. 2003/0110011 A1 to Kyotoku (hereinafter "Kyotoku") in view of Wall. Applicant respectfully traverses and requests withdrawal of this rejection, for at least the following reasons.

Claim 8

For at least the following reasons, the portions of Kyotoku and Wall cited by the Examiner do not teach or suggest the system of independent claim 8.

The Examiner admits on page 7 of the Office Action that Kyotoku does not teach, suggest or disclose the feature of "means for, upon determining that the physical location of the client computer is not within the first list of authorized location ranges, requesting a download of a second software." However, the Examiner fails to acknowledge the lack of Kyotoku to teach, suggest or disclose the complete recited feature of claim 8, which is "means for, upon

determining that the physical location of the client computer is not within the first list of authorized location ranges, requesting a download of a second software, the second software having a second list of authorized location ranges." (Emphasis added)

Furthermore, although the Examiner admits on page 7 of the Office Action that Kyotoku fails to teach or suggest the feature of, among other things, "requesting a download of a second software," the Examiner fails to acknowledge that Kyotoku also fails to teach, suggest or disclose additional recited features of claim 8 associated with the second software, including "means for comparing the physical location of the client computer with the second list of authorized location ranges," and "means for downloading the second software only if the physical location of the client computer is within the range of one of the authorized location ranges from the second list of authorized location ranges." Therefore, as inherently admitted by the Examiner, and as an apparent oversight for not specifically stating so, these features also are clearly no taught or suggested in Kyotoku.

The Examiner refers to paragraph [0103] of Wall to allegedly be the equivalent of the recited features of claim 8 not taught or suggested in Kyotoku, but respectfully such reliance by the Examiner is misplaced. Paragraph [0103] of Wall states merely that:

> **[0103]** It is then determined, at step s515, whether the ("current") access/usage parameters match the ("pre-stored") permission parameters. If the parameters match ("Y"), process **500** allows normal access/usage of the controlled system/commodity, as shown by step s520. If the parameters do not match ("N"), process **500** may prohibit or limit the access/usage, as shown by step s525.

Paragraph [0101] of Wall further explains the "permission parameters" and their function, as follows:

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to a memory of a control system. Such permission parameters may include geographic location where controlled software is permitted to be used or where controlled commodity is allowed to be accessed, time at which such access/usage is permitted, etc. Step s505 may be performed as an initialization or production step of a software system, a commodity delivery system, etc. (i.e., before the system leaves a production facility). It may also be a subscription initialization or updating step at an already authorized site, such as a primary location for software use.

Paragraph [0110] of <u>Wall</u> further explains the function of "step s525", as follows:

unauthorized use. For example, step s525 of process 500 may include altering a state of a delivered object in such a manner as to make it permanently unsuited for use at other than a licensed location.

Additionally, paragraph of <u>Wall</u> further explains the function of "step s525", as follows:

[0115] In accordance with another embodiment, software Dynamic Link Libraries ("DLLs") necessary for operation can be erased (at, say, step s525) unless timely position (or location) data is input. The vendor can then be contacted via the Internet to reinstall the DLL for a limited time.

As can be seen, there is no teaching or suggestion in <u>Wall</u> of requesting a second software if a physical location of a client computer is not within an authorized location range for a first software from a first list of authorized location ranges (associated with the first software).

In fact, the various paragraphs of <u>Wall</u> cited above merely describe a process to preclude or limit <u>a single software</u> from being accessed/used if permission parameters, which may include geographic information, are not complied with. As described above, the functions of the process described in paragraph [0103] of <u>Wall</u>, cited by the Examiner, do not include any reference of a second software being requested when a first software is not permitted to be downloaded based on geographic information.

Therefore, the portions of <u>Kyotoku</u> and <u>Wall</u> cited by the Examiner do not teach or suggest, among other things, a system for regulating a download of a software from a server to

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a client computer on a network, including, among other things, the features of "means for, upon determining that the physical location of the client computer is not within the first list of authorized location ranges, requesting a download of a second software, the second software having a second list of authorized location ranges; means for comparing the physical location of the client computer with the second list of authorized location ranges, and means for downloading the second software only if the physical location of the client computer is within the range of one of the authorized location ranges from the second list of authorized location ranges," as recited in independent claim 8. (Emphasis added) Thus, for at least the above reasons, independent claim 8 is patentably distinguishable over Kyotoku and Wall, separately and in combination. Accordingly it is respectfully requested that the rejection of this claim be withdrawn, and allowance of claim 8 is earnestly solicited.

Claims 10-12 and 19

Regarding dependent claims 10-12 and 19, since these claims depend from independent claim 8, they include all of the features of independent claim 8, as described above. For at least the reasons given above regarding independent claim 8, neither Kyotoku nor Wall, separately or in combination, teaches or suggests all the features of these dependent claims. Therefore, claims 10-12 and 19 are patentably distinguishable over Kyotoku and Wall, and accordingly, it is respectfully requested that the rejection of these claims be withdrawn, and allowance of claims 10-12 and 19 is earnestly solicited.

Claims 13 and 14 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Kyotoku in view of Wall and further in view of U.S. Patent Publication No. 2002/0082025 A1 to Baese et al. (hereinafter "Baese"). Applicant respectfully traverses and requests withdrawal of this rejection, for at least the following reasons.

Claims 13 and 14

Regarding dependent claims 13 and 14, since these claims depend from independent claim 8, they include all of the features of independent claim 8, as described above. For at least the reasons given above regarding independent claim 8, neither Kyotoku nor Wall, separately or in combination, teaches or suggests all the features of these dependent claims.

Additionally, Baese does not overcome the deficiencies of Kyotoku and Wall described

above in regard to independent claim 8, nor was <u>Baese</u> cited by the Examiner for that purpose. Therefore, neither <u>Kyotoku</u>, <u>Wall</u> nor <u>Baese</u>, separately or in combination, teaches or suggests all the features of these dependent claims 13 and 14. Accordingly, it is respectfully requested that the rejection of these claims be withdrawn, and allowance of claims 13 and 14 is earnestly solicited.

Conclusion

It is respectfully submitted that a full and complete response has been made to the outstanding Office Action and, as such, there being no other objections or rejections, this application is in condition for allowance, and a notice to this effect is earnestly solicited.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided below.

No extension of time for this response is believed to be necessary. However, in the event an extension of time is required, that extension of time is hereby requested. Please charge any fee associated with an extension of time, as well as any other fee necessary to further the prosecution of this application, to IBM Corporation Deposit Account No. 09-0447.

Respectfully submitted,

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